

ESTTA Tracking number: **ESTTA624999**

Filing date: **09/03/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Technogym S.p.A.
Granted to Date of previous extension	09/03/2014
Address	Via G. Perticari, 20 Gambettola (FC), 47035 ITALY

Attorney information	Michael A. Grow Arent Fox LLP 1717 K Street, NW Washington, DC 20036 UNITED STATES grow.michael@arentfox.com, giuliani.chiara@arentfox.com, henrye@arentfox.com, tmdocket@arentfox.com Phone:202 857 6389
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Applicant Information

Application No	86108295	Publication date	05/06/2014
Opposition Filing Date	09/03/2014	Opposition Period Ends	09/03/2014
Applicant	Maryland Athletic Club & Wellness Center L.L.C. 110 W. Timonium Road Timonium, MD 21093 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2007/01/31 First Use In Commerce: 2007/01/31 Opposed goods and services in the class: Physical fitness consultation and instruction for developing physical health for individuals using strength and balancetraining, flexibility training, endurance training, and rest and rejuvenation
Class 044. First Use: 2007/01/31 First Use In Commerce: 2007/01/31 All goods and services in the class are opposed, namely: Providing assistance, fitness evaluation and consultation to help improve emotional and physical health; nutrition counseling

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)


Marks Cited by Opposer as Basis for Opposition


U.S. Registration	2619545	Application Date	04/11/2000
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No.			
Registration Date	09/17/2002	Foreign Priority Date	03/15/2000
Word Mark	MY WELLNESS		
Design Mark	<p style="text-align: center;">MY WELLNESS</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 COMPUTER SOFTWARE ON DISK OR TAPE FOR CONTROLLING, MANAGEMENT AND PLANNING AEROBIC AND CARDIOVASCULAR PHYSICAL EXERCISEMACHINES AND APPARATUS; [COMPUTER TERMINALS FOR CONTROLLING, [RECORING] * RECORDING * AND MONITORING AEROBIC AND CARDIOVASCULAR PHYSICAL EXERCISE MACHINES AND APPARATUS; [COMPUTER SOFTWARE ON DISK OR TAPE FOR CONTROLLING, MANAGEMENT AND PLANNING [OR] * OF * GYMNASIUMS AND BIOMEDICAL REHABILITATION CENTERS;] MAGNETIC CODED CARDS]</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 [INSTRUCTION MANUALS FOR PHYSICAL EXERCISES, REHABILITATION AND MEDICAL, MUSCULAR, AEROBIC AND CARDIOVASCULAR CHECK-UPS, THROUGH PHYSICAL EXERCISES]</p>		


U.S. Registration No.	2606995	Application Date	01/11/2001
Registration Date	08/13/2002	Foreign Priority Date	07/28/2000
Word Mark	MY WELLNESS		
Design Mark	<p style="text-align: center;">MY WELLNESS</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 0 First Use In Commerce: 0 TECHNICAL CONSULTANCY IN THE MANAGEMENTAND USE OF COMPUTERS, COMPUTER SOFTWAREAPPLICATIONS, EQUIPMENT FOR PHYSICAL EXERCISE AND MUSCLE REHABILITATION, AND DATABASES, ALL RELATING TO ACTIVITIES FOR PERSONAL FITNESS AND PHYSICAL WELL-BEING</p>		

U.S. Registration No.	2671542	Application Date	09/14/2001
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Registration Date	01/07/2003	Foreign Priority Date	08/31/2001
Word Mark	WELLNESS SYSTEM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 computer software recorded on disk and tape for controlling and managing physical aerobic and cardiovascular physical exercise machines and equipment [computers; computer printers; video screens; computer terminals for controlling and managing physical, aerobic and cardiovascular machines and equipment, for monitoring the exercises performed using such machines and equipment, and for controlling, managing and designing gymnasiums and bio-medical rehabilitation centers; magnetic coded cards]		

U.S. Registration No.	3656065	Application Date	02/29/2008
Registration Date	07/14/2009	Foreign Priority Date	NONE
Word Mark	WELLNESS REWARDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2008/09/30 First Use In Commerce: 2008/09/30 Arranging and conducting incentive award programs to encourage the frequent, continued and effective practice of physical exercise		

U.S. Registration	4255912	Application Date	07/27/2010
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No.			
Registration Date	12/11/2012	Foreign Priority Date	02/12/2010
Word Mark	BE WELLNESS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electric current; apparatus for recording, transmission or reproduction of sound or image; blank magnetic data carriers; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire-extinguishing apparatus; software programs on disc for use in database management in the field of aerobic and cardiovascular exercise; multi-functional computer terminals for management and control of equipment and machines for physical, aerobic and cardiovascular exercises and for management and control of exercises using such machines and equipment, and for control, management and design of gymnasiums and bio-medical rehabilitation centers; magnetic encoded cards; portable digital electronic devices and software related thereto for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files; handheld digital electronic devices and software related thereto for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files; MP3 players; hand held computers; personal digital assistants; electronic personal organizers; electronic notebook computers; blank magnetic data carriers; prerecorded magnetic data carriers featuring computer software; for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files; mobile digital electronic devices, namely, mobile data receivers, distance measuring apparatus, distance recording apparatus, pedometers, portable measurer and motivator of physical activity containing a UBS port; computer monitors; electronic display interfaces; liquid crystal displays; optical disk drives; keyboards, electric cables, modems, computer disk drives and printers; videophones; cameras; computer software and pre-recorded computer programs for personal information management; database management software; software for optical character recognition; telephony management software, namely, digital telephone platforms and software and computer telephony software; computer software; for sending and transmitting electronic mail, electronic messages and data to pagers; computer application software for mobile phones, namely, software for database management and for use in electronic storage of data for distance recording and measuring, for receiving and generating motivational messages for physical activity; database synchronization software; computer programs for accessing, browsing and searching online databases; computer software and firmware for operating system programs; computer programs for data synchronization programs; computer programs for developing computer applications for personal and handheld computers; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages; electronic devices that enable the user to keep track of or</p>		

	<p>manage personal information by recording, organizing, transmitting, manipulating and reviewing text, data, image and audio files; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device in the nature of mobile phones, laptop computers and other portable and handheld digital electronic devices, and another station or device or fixed station or device in the nature of desktop computers or network servers</p> <p>Class 010. First use: First Use: 0 First Use In Commerce: 0</p> <p>medical apparatus and instrument, namely, medical machines and equipment for exercise, rehabilitation and for medical, muscular, aerobic and cardiovascular control, by means of physical exercises carried out using such machines and equipment, namely, treadmills, step machines, rowing-machines, cycling machines for medical purposes</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0</p> <p>paper, cardboard; goods made from paper and cardboard, namely, cardboard boxes, cardboard tubes, cardboard packaging, banners of paper, filter paper, hat boxes of paper, label paper, notebook paper, printed menus, printed music books, printed patterns, and printed publications, namely, books, magazines, newspapers, manuals, periodicals, leaflets, catalogues in the field of gymnastics, sport, muscle training, psycho-physical well-being, culture; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials, namely, paint brushes; office requisites, namely, typewriters; printed instructional and teaching materials in the field of aerobic and cardiovascular exercises and training; plastic bags for packaging; printers' type; printing blocks; pens; pencils; writing or drawing notebooks</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0</p> <p>leather and imitations of leather, and goods made of these materials, namely, animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0</p> <p>clothing, namely, jackets, shirts pants, shorts, t-shirts and gymnastic clothing, namely, jersey, leotards, sweatshirts and sweatpants; footwear; headwear</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0</p> <p>machines and equipment for physical and gymnastic/sports exercises, for aerobic and cardiovascular exercise, for muscle rehabilitation, namely, treadmills, step simulators, rowing machines, cycle simulators, all for muscle training and rehabilitation; gymnastic and sporting articles, namely, barbells, exercise weights, dumbbells, and athletic ankle supports not for medical use</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>advertising and business management consulting; business administration and office functions; consultancy relating to the organization and business and control management of gymnasiums and bio-medical rehabilitation centers and of gymnastics/sports centers; promotion of gymnastic/sports events, sporting competitions and events in the sectors of gymnastics, sport and muscle rehabilitation; collection and compilation of information into computer databases in the field of personal wellbeing; professional business consultancy; promoting sports competitions and/or events of others; organization of events in the nature of sporting, gymnastic and cultural exhibitions, fairs and shows for promotional purposes; organizing of events in the field of muscle rehabilitation for promotional purposes; organizing and promoting exhibitions in the fields of gymnastic/sports events, sporting competitions and events in the field of gymnastics, sports and muscle rehabilitation for business purposes; industrial analysis in the field of gymnastics and bio-medical rehabilitation, namely, cost/yield analysis to reduce corporate health expenses in the development of gymnastic and rehabilitation programs</p>
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	<p>Class 041. First use: First Use: 0 First Use In Commerce: 0</p> <p>education services, namely, providing classes, seminars and workshops in the field of gymnastics, sport and muscle rehabilitation; training services in the field of gymnastics, sport and muscle rehabilitation; entertainment in the nature of competitions in the field of gymnastics and sports; entertainment in the nature of gymnastic performances; entertainment in the nature of on-going television programs in the field of muscle rehabilitation; entertainment services, namely, providing webcasts and podcasts in the field of muscle rehabilitation; organizing sporting and cultural exhibitions for entertainment purposes; physical education; conducting distance learning, namely, providing online training in the form of courses, seminars and workshops in the field of personal fitness and physical-wellbeing; providing information in the field of physical fitness; arranging of colloquiums, symposiums, seminars, and round tables in the personal fitness and physical wellbeing sector not for business purposes; organizing gymnastic and sporting exhibitions and muscle rehabilitation exhibitions for entertainment purposes</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>technological consultation in the field of selecting equipment in the field of gymnastics, sport and muscle rehabilitation suitable for their intended uses; scientific and technological services, namely, scientific research and product design in the field of gymnastics, sport and muscle rehabilitation; industrial research services in the field of gymnastics, sport and muscle rehabilitation; design and development of computer hardware and software; computer programming for management and control of equipment and machines for physical, aerobic and cardiovascular exercises and for management and exercises performed using these machines and equipment, and for control, management and design of gymnasia and bio-medical rehabilitation centers; consultancy services relating to the design of gymnasia and bio-medical rehabilitation centers and of gymnastics/sports centers</p>
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Attachments	<p>76022978#TMSN.png(bytes) 76192442#TMSN.png(bytes) 76312848#TMSN.png(bytes) 77410179#TMSN.png(bytes) 85093708#TMSN.png(bytes) Wellness System opp.pdf(289022 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael A. Grow/
Name	Michael A. Grow
Date	09/03/2014

In re Application No. 86/108,295 for the mark WELLNESS SYSTEM filed on November 1, 2013, and published on May 6, 2014

Opp. No. _____

Technogym S.p.A. (“Opposer”) believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

1. Opposer is the owner of all right, title and interest in and to the mark WELLNESS SYSTEM and a family of other marks containing the word “WELLNESS” (“the WELLNESS Marks”).

2. These marks are used in connection with various physical exercise-related goods and services, including providing classes, seminars and workshops in the field of gymnastics, sport and muscle rehabilitation.

3. The PTO has recognized Opposer's exclusive rights in the WELLNESS Marks by issuing various registrations, including the following:

- AFDOCS/11269301.1

- b. Reg. No. 2,606,995 MY WELLNESS for technical consultancy in the management and use of computers, computer software applications, equipment for physical exercise and muscle rehabilitation, and databases, all relating to activities for personal fitness and physical well-being, in Int. Class 42, issued on August 13, 2002



- c. Reg. No. 2,671,542 for physical exercise-related software in Int. Class 9, issued on January 7, 2003
- d. Reg. No. 3,656,065 WELLNESS REWARDS for Arranging and conducting incentive award programs to encourage the frequent, continued and effective practice of physical exercise, in Int. Class 421, issued on July 14, 2009
- e. Reg. No. 4,255,912 BE WELLNESS for various goods and services in Int. Classes 9, 10, 16, 18, 25, 28, 35, 41 and 42, including education services, namely, providing classes, seminars and workshops in the field of gymnastics, sport and muscle rehabilitation, in Int. Class 41, issued on December 11, 2012

4. Opposer's registrations are valid and subsisting, and Reg. No. 2,619,545 is incontestable. Thus, these registrations provide *prima facie* and in some instances conclusive evidence of Opposer's ownership of, and exclusive right to use, its WELLNESS Marks in commerce.

5. Opposer was founded in Italy in 1983 and its innovation and human centric technology has enabled Opposer to become one of world's leading manufacturers of exercise and rehabilitation machines, equipment and related products and services.

6. Opposer's products and services are widely used by private individuals, fitness centers, medical centers and many other products.

7. In view of the extraordinary quality of its innovative products, Opposer has become the official supplier for some of the best sport teams in the world, including soccer teams such as Juventus, Inter, Milan, Paris Saint Germain, and Ajax; America's Cup sailing teams Luna Rossa, Alinghi and Oracle; and Formula One auto racing teams Ferrari and Maclaren; and tennis champion Rafael Nadal.

8. Opposer also was selected as the exclusive supplier of fitness equipment at some of the most important international sports events, including the America's Cup, the Sydney 2000 Olympics, the Athens 2004 Olympics, the Turin 2006 Winter Olympics, the Beijing 2008 Olympics and the London 2012 Olympics.

9. Opposer's WELLNESS Marks have been used widely for many years in the United States, and they are very valuable assets and symbols of Opposer's goodwill.

10. Since long prior to the acts complained of herein, Opposer has extensively used the WELLNESS Marks in the United States directly or through its related companies for various products and services including software related to physical exercise, diet and physical and mental well being, and providing classes, seminars and workshops in the field of gymnastics, sport and muscle rehabilitation.

11. Notwithstanding Opposer's prior rights in WELLNESS SYSTEM and the other WELLNESS Marks, Applicant filed the above referenced application for registration of the identical mark WELLNESS SYSTEM for "Physical fitness consultation and instruction for developing physical health for individuals using strength and balance training, flexibility training, endurance training, and rest and rejuvenation" in Int. Class 41 and "Providing assistance, fitness evaluation and consultation to help improve emotional and physical health; nutrition counseling" in Int. Class 44.

12. The parties' marks are identical and the goods and services are very closely related.

13. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of the above referenced application.

14. Upon information and belief, Applicant actually knew of or had reason to know of Opposer's famous WELLNESS Marks when Applicant filed its application.

COUNT I

LIKELIHOOD OF CONFUSION - §2(d)

15. The mark that Applicant seeks to register so resembles Opposer's WELLNESS Marks that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's WELLNESS Marks.

16. Applicant's services are so closely related to those sold under Opposer's WELLNESS Marks that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

17. Likelihood of confusion is enhanced by the fact that Applicant's alleged mark WELLNESS SYSTEM is identical to Opposer's mark WELLNESS SYSTEM and Applicant's services are virtually identical to or closely related to the services sold under Opposer's WELLNESS Marks.

18. Likelihood of confusion is enhanced by the success of Opposer's WELLNESS Marks and by the fact that consumers associate said marks with goods and services sold, approved or endorsed by Opposer.

19. Likelihood of confusion is enhanced by the fact that prospective purchasers of Applicant's services are also prospective purchasers of products sold under Opposer's

WELLNESS Marks and Applicant's services would be sold through at least some of the same channels of trade as Opposer's goods.

20. Therefore, registration should be denied on the grounds that Applicant's mark is likely to cause confusion.

COUNT II

FALSE SUGGESTION OF CONNECTION - §2(a)

21. Applicant's alleged mark so closely resembles Opposer's Marks that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the services, and this is likely to materially alter purchasers' decisions to acquire Applicant's services.

22. Applicant's alleged mark so closely resemble Opposer's Marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer and purchasers will assume that services offered under Applicant's alleged mark are connected with Opposer.

23. When Applicant's alleged mark is used on services of the type described in its application, Applicant's alleged mark will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's services by permitting Applicant's alleged mark to be used on such services.

24. Opposer's mark is used in such a manner that it serves as the name or identity of Opposer in addition to serving as a mark.

25. Applicant's alleged mark is the same as, or is a close approximation of, the name or identity previously used by Opposer.

26. Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Opposer.

27. Applicant is not connected with Opposer and Opposer is not connected with any activities performed by Applicant under Applicant's alleged mark.

28. Opposer's fame or reputation is such that, when Applicant's alleged mark is used with the applicant's alleged services, a connection with Opposer would be presumed.

29. Applicant's mark is deceptive in that it falsely suggests a connection with, or approval by, Opposer.

30. Therefore, registration of Applicant's alleged mark should be denied on the grounds that it falsely suggests a connection with Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TECHNOGYM S.P.A.

By 

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Telephone: (202) 857-6000

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing (re S/N 86/108,295) is being served upon Applicant's counsel F. Scott Johnson of Ober, Kaler, Grimes & Shriver at 100 Light Street, FL B2, Baltimore, Maryland 21202 by first class mail, postage prepaid, on September 3, 2014.

A handwritten signature in dark ink, appearing to read "F. Scott Johnson", is written over a horizontal line.